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# FEE TRANSMITTAL for FY 2003

Effective 01/01/2003. Patent fees are subject to annual revision.

Applicant claims small entity status. See 37 CFR 1.27

**TOTAL AMOUNT OF PAYMENT** **(\$)** 320.00

**Complete if Known**

|                      |                     |
|----------------------|---------------------|
| Application Number   | 09/407,053          |
| Filing Date          | 09/27/1999          |
| First Named Inventor | Richard L. Palinkas |
| Examiner Name        | B. Pezzlo           |
| Art Unit             | 3683                |
| Attorney Docket No.  | 6350-05             |

**METHOD OF PAYMENT (check all that apply)**

Check  Credit card  Money Order  Other  None

Deposit Account:

Deposit Account Number  
13-0235  
Deposit Account Name  
McCormick, Paulding & Huber

The Commissioner is authorized to: (check all that apply)

Charge fee(s) indicated below  Credit any overpayments

Charge any additional fee(s) during the pendency of this application

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**FEE CALCULATION****1. BASIC FILING FEE**

| Large Entity Fee Code (\$) | Small Entity Fee Code (\$) | Fee Description               | Fee Paid |
|----------------------------|----------------------------|-------------------------------|----------|
| 1001                       | 2001                       | 750 375 Utility filing fee    |          |
| 1002                       | 2002                       | 330 165 Design filing fee     |          |
| 1003                       | 2003                       | 520 260 Plant filing fee      |          |
| 1004                       | 2004                       | 750 375 Reissue filing fee    |          |
| 1005                       | 2005                       | 160 80 Provisional filing fee |          |
| <b>SUBTOTAL (1) (\$)</b> 0 |                            |                               |          |

**2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE**

| Total Claims | Independent Claims | Extra Claims | Fee from below   | Fee Paid |
|--------------|--------------------|--------------|--|----------|
|              |                    | -20**        | = <input type="text"/> X <input type="text"/> = <input type="text"/> |          |
|              |                    | -3**         | = <input type="text"/> X <input type="text"/> = <input type="text"/> |          |

| Large Entity Fee Code (\$) | Small Entity Fee Code (\$) | Fee Description   | Fee Paid |
|----------------------------|----------------------------|---|----------|
| 1202                       | 2202                       | 18 9 Claims in excess of 20                                     |          |
| 1201                       | 2201                       | 84 42 Independent claims in excess of 3                         |          |
| 1203                       | 2203                       | 280 140 Multiple dependent claim, if not paid                   |          |
| 1204                       | 2204                       | 84 42 ** Reissue independent claims over original patent        |          |
| 1205                       | 2205                       | 18 9 ** Reissue claims in excess of 20 and over original patent |          |
| <b>SUBTOTAL (2) (\$)</b> 0 |                            |   |          |

\*\*or number previously paid, if greater. For Reissues, see above

**FEE CALCULATION (continued)****3. ADDITIONAL FEES**

| Large Entity Fee Code (\$)        | Small Entity Fee Code (\$) | Fee Description  | Fee Paid                        |
|-----------------------------------|----------------------------|--|---------------------------------|
| 1051                              | 2051                       | 130 65 Surcharge - late filing fee or oath                                       |                                 |
| 1052                              | 2052                       | 50 25 Surcharge - late provisional filing fee or cover sheet                     |                                 |
| 1053                              | 2053                       | 130 130 Non-English specification  |                                 |
| 1812                              | 1812                       | 2,520 2,520 For filing a request for ex parte reexamination                      |                                 |
| 1804                              | 1804                       | 920* 920* Requesting publication of SIR prior to Examiner action                 |                                 |
| 1805                              | 1805                       | 1,840* 1,840* Requesting publication of SIR after Examiner action                |                                 |
| 1251                              | 2251                       | 110 55 Extension for reply within first month                                    |                                 |
| 1252                              | 2252                       | 410 205 Extension for reply within second month                                  |                                 |
| 1253                              | 2253                       | 930 465 Extension for reply within third month                                   |                                 |
| 1254                              | 2254                       | 1,450 725 Extension for reply within fourth month                                |                                 |
| 1255                              | 2255                       | 1,970 985 Extension for reply within fifth month                                 |                                 |
| 1401                              | 2401                       | 320 160 Notice of Appeal   |                                 |
| 1402                              | 2402                       | 320 160 Filing a brief in support of an appeal                                   |                                 |
| 1403                              | 2403                       | 280 140 Request for oral hearing   |                                 |
| 1451                              | 1451                       | 1,510 1,510 Petition to institute a public use proceeding                        |                                 |
| 1452                              | 2452                       | 110 55 Petition to revive - unavoidable  |                                 |
| 1453                              | 2453                       | 1,300 650 Petition to revive - unintentional                                     |                                 |
| 1501                              | 2501                       | 1,300 650 Utility issue fee (or reissue)   |                                 |
| 1502                              | 2502                       | 470 235 Design issue fee   |                                 |
| 1503                              | 2503                       | 630 315 Plant issue fee  |                                 |
| 1460                              | 1460                       | 130 130 Petitions to the Commissioner  |                                 |
| 1807                              | 1807                       | 50 50 Processing fee under 37 CFR 1.17(q)  |                                 |
| 1806                              | 1806                       | 180 180 Submission of Information Disclosure Stmt                                |                                 |
| 8021                              | 8021                       | 40 40 Recording each patent assignment per property (times number of properties) |                                 |
| 1809                              | 2809                       | 750 375 Filing a submission after final rejection (37 CFR 1.129(a))              |                                 |
| 1810                              | 2810                       | 750 375 For each additional invention to be examined (37 CFR 1.129(b))           |                                 |
| 1801                              | 2801                       | 750 375 Request for Continued Examination (RCE)                                  |                                 |
| 1802                              | 1802                       | 900 900 Request for expedited examination of a design application                |                                 |
| Other fee (specify) _____         |                            |  |                                 |
| *Reduced by Basic Filing Fee Paid |                            |  | <b>SUBTOTAL (3) (\$)</b> 320.00 |

**(Complete if applicable)**

|                   |   |                                   |        |           |              |
|-------------------|---|-----------------------------------|--------|-----------|--------------|
| Name (Print/Type) | Donald J. MacDonald   | Registration No. (Attorney/Agent) | 42,823 | Telephone | 860-549-5290 |
| Signature         |  |                                   |        | Date      | 4/17/03      |

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**GROUP 3600**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the Application of:

Richard L. Palinkas )  
Title: SIDE BEARING PAD ) Examiner: B. Pezzlo  
Serial No.: 09/407,053 ) Group Art Unit: 3683  
Filed: September 27, 1999 )  
 ) (Our Docket No. 6350-05)

Hartford, Connecticut, April 17, 2003

Box: AF  
Assistant Commissioner for Patents  
Washington, DC 20231

APPELLANT'S BRIEF TO THE BOARD OF PATENT APPEALS AND  
INTERFERENCES PURSUANT TO 37 C.F.R. §1.191

Dear Sirs:

This appeal is taken from the Final Office Action mailed November 19, 2002.

REAL PARTY IN INTEREST

The real party in interest with respect to the above-identified patent application is: Uniroyal Chemical Company, Inc., World Headquarters, Middlebury Connecticut 06749.

### RELATED APPEALS AND INTERFERENCES

Appellant and the undersigned attorney are not aware of any pending patent appeal or interference proceeding related to the above-referenced application.

### STATUS OF CLAIMS

Claims 1, 3, 5 - 8, 10 - 15 and 17 - 22 are pending in the application and stand rejected by the Examiner under 35 U.S.C. §103(a). All rejected claims are presented to the Board for reconsideration.

### STATUS OF AMENDMENTS

No amendments have been filed subsequent to the Final Office Action dated November 19, 2002.

### SUMMARY OF THE INVENTION

Following is a brief description of each claim under appeal including specific references to the specification and drawings wherein support for each claim can be found in the Application.

Independent claim 1 is directed to a bearing pad assembly (10) having first and second housings (30, 40). The first housing (30) has an exterior surface (32) and defines a bore (34) at least part-way through the first housing. A first load bearing member (36) is coupled to the first housing and defines an outwardly facing first abutment surface (38). A second housing (40) defines a bore (44) of a shape similar to the exterior surface of the first housing and is adapted to slideably receive the first housing therein. A second load bearing member (46) is coupled to the second housing and defines an outwardly facing second abutment surface (48) opposite to the first abutment surface (38). (See Spec., p. 4, ll. 28 - 34; Figs. 1 and 2).

Claim 1 further includes, at least one slip lining (50) positioned between the first housing exterior surface (32) and a bore wall defining the second housing bore, and at least one compression spring (62) positioned

within the first housing bore (34). The compression spring comprises a solid resilient material having a toroidal shape. The toroid has an outside diameter minus an inside diameter equal to or greater than a height when positioned in the bearing pad assembly. (See Spec., p. 5, ll. 1 - 29; Figs. 1 and 2; See also, Spec. p. 6, ll. 11 - 17 as amended June 14, 2002)

Claim 3, which depends from claim 1, further recites that the compression spring deforms non-linearly in response to the load imposed on at least one of the abutment surfaces. (See Spec., p. 6, ll. 16 - 34; p. 7, ll. 1 - 7; Fig. 3). The spring provides a force resisting compression generally at an increasing rate when progressively compressed, thereby providing a low initial impulse, but a high ultimate resistance to compression in urging the first and second abutment surfaces away from each other in response to a load imposed on at least one of the abutment surfaces. (See Spec., pg. 6, ll. 30 - 34; pg. 7, l. 1; Fig. 3).

Claim 5, which depends from claim 1, further recites that the solid resilient material is substantially an organic polymer. (See Spec., p. 6, ll. 11 and 12).

Claim 6, which depends from claim 5, further recites that the organic polymer is substantially polyurethane. (See Spec., p. 6, ll. 11 and 12).

Claim 7, which depends from claim 1, further recites that the solid resilient material is in the form of a toroidal ring having a circular cross-section. (See Spec., p. 6, ll. 11 and 12).

Claim 8, which depends from claim 1, further recites that the bearing pad assembly includes at least two springs and a plate positioned between the springs, separating the springs from one another. (See Spec., p. 5, ll. 30 - 34; p. 6, ll. 1 - 10; Figs. 1 and 2).

Claim 10 depends from claim 1 and further recites the slip lining having a coefficient of static friction less than that of the first housing. (See Spec., p. 5, ll. 20 - 22).

Claim 11 depends from claim 1 and further recites that the slip lining is attached to the first housing exterior surface. (See Spec., p. 4, ll. 1 - 3).

Claim 12, which depends from claim 1, further recites that the second slip lining is attached to the second housing exterior wall. (See Spec., p. 4, ll. 1 - 3).

Claim 13 depends from claim 1 and further recites that the slip lining is made substantially from an organic polymer. (See Spec., p. 5, ll. 24 - 26).

Claim 14 depends from claim 1 and further recites that the slip lining is made substantially of polypropylene. (See Spec., p. 5, ll. 24 - 26).

Claim 17 depends from claim 1 and further recites that the compression spring has a largest diameter slightly smaller than the diameter of the first housing. (See Spec., p. 5, ll. 33 - 34; p. 6, line 1; Figs. 1 and 2).

Claim 18 depends from claim 1 and further defines the toroidal shape of the compression spring having an inner most point of a cross section of the toroidal shape being on a line drawn perpendicular to an axis of rotation of the spring through the geometric center of the cross section. (See Spec., p. 5, ll. 1 - 29; Figs. 1 and 2; See also, Spec. p. 6, ll. 11 - 17 as amended June 14, 2002)

Independent claim 15, recites the spring as defined in claim 1 without the at least one slip lining. (See Spec., p. 5, ll. 26 - 29; Figs. 1 2).

Claim 19 depends from claim 15 and further recites two compression springs positioned within the first housing bore. (See Spec., p. 3., ll. 17 -28; p. 5, ll. 30 - 34; p. 6, ll. 1 - 7; Figs. 1 and 2).

Claim 20 depends from claim 19 and includes a plate positioned between the springs, separating the springs from one another. (See Spec., p. 3., ll. 17 -28; p. 5, ll. 30 - 34; p. 6, ll. 1 - 10; Figs. 1 and 2).

Claim 21 depends from claim 15 and further includes a first slip lining attached to the first housing exterior surface. (See Spec., p. 5, ll. 5 - 29; Fig. 1).

Claim 22 depends from claim 21 and further recites a second slip lining attached to the second housing bore wall. (See Spec., p. 5., ll. 5 - 29; Fig. 1).

## ISSUES

Issue 1: Whether claims 1, 3, 5 - 8, 10 - 14, 17 and 18 are unpatentable under 35 U.S.C. §103(a) over Carlston (U.S. Pat. No. 4,998,997), (herein "Carlston") in view of Magowan (U.S. Pat. No. 136,079), (herein "Magowan"), in view of Platkiewicz et al. (U.S. Pat. No. 4,465,799), (herein "Platkiewicz "), and further in view of Curtis et al. (U.S. Pat. No. 5,036,774), (herein "Curtis ") and Spencer et al. (U.S. Pat. No. 5,086,707), (herein "Spencer").

Issue 2: Whether claims 15, 19 and 20 are unpatentable under 35 U.S.C. §103(a) over Carlston in view of Magowan.

Issue 3: Whether claims 21 and 22 are unpatentable under 35 U.S.C. §103(a) over Carlston in view of Magowan in view of Platkiewicz and further in view of Curtis and Spencer.

## GROUPING OF CLAIMS

Appellant submits that the claims in each of the following groups do not stand or fall together to the extent set forth below in the Argument section.

Group 1: Claims 1, 3, 5 - 8, 10 - 14, 17 and 18

Group 2: Claims 15, 19 and 20

Group 3: Claims 21 and 22

## ARGUMENT

### Issue 1

The Examiner has rejected claims 1, 3, 5 - 8, 10 - 14, 17 and 18 under 35 U.S.C. §103(a) as being unpatentable over Carlston in view of Magowan in view of Platkiewicz and further in view of Curtis and Spencer.

An obviousness rejection based on a combination of selected elements in the prior art requires that there be some teaching or suggestion whereby it would have been obvious to someone of ordinary skill in the art to make the particular selection and combination made by the Appellant. In re O'Farrell, 7 U.S.P.Q.2d 1673, 1680 (Fed. Cir. 1988); In re

Fine, 5 U.S.P.Q.2d 1596, 1598-99 (Fed. Cir. 1988); Uniroyal, Inc. v. Rudkin-Wiley Corp., 5 U.S.P.Q.2d 1434, 1438 (Fed. Cir. 1988); Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc., 230 U.S.P.Q. 416, 419 (Fed. Cir. 1986). As set forth below, it is respectfully submitted that there is no teaching or suggestion in the prior art to combine the references applied by the Examiner, namely, Carlston, Magowan, Platkiewicz, Curtis, and Spencer, and thereby render obvious the invention recited in claims 1, 3, 5 - 8, 10 - 14, 17 and 18 of the application under appeal.

The Carlston reference teaches a side bearing unit for articulated railroad cars. "The side bearing unit of this invention is designed to meet the unique demands of articulated car service." (Carlston, col. 1, ll. 55 and 56). The Carlston side bearing unit includes a housing 54, a round top cap 32, and a pair of elastomeric springs 36 and 38 accommodated therebetween. The springs are open-ended hollow tubes. (Carlston, col. 3, ll. 62 and 63; Fig. 7). The springs are designed to fold and flex so that during a normal work cycle, the slope of the force vs. travel curve remains as flat as possible. (Carlston, col. 3, l. 64 to col. 4, l. 1; Fig. 3). The elastomeric spring is designed so that throughout its total travel from free height, it is folding and flexing rather than compressing. (Carlston, col. 4, ll. 15 - 17).

Additionally, the Carlston reference teaches that the spring has a loading area that remains essentially the same throughout its total travel in a work cycle. This is accomplished by designing the spring so that the outside diameter minus the inside diameter is less than the height within the side bearing. (See col. 4, ll. 17 - 22).

"The combined effect of elastomer springs in series, and fold or flex of the elastomer, and the generally constant loaded areas result in the low spring rate or flat force versus travel curve as in Fig. 3. This low spring rate is of great importance in order to satisfy the unique demands of articulated cars. A high spring rate would result in possible derailment while the car is traversing a super elevated curve or in the case of the worn articulated connection as previously described." (Carlston, col. 4, ll. 5 - 14).

Magowan teaches a solid toroidal spring having a circular cross-section. The Magowan spring is designed to be compressed under load.

(Magowan, col. 2, ll. 16 - 18).

Platkiewicz discloses a low-friction slide lining composition and a method of producing the slide lining composition. (Platkiewicz, col. 1, ll. 6 - 9).

Curtis discloses a long-travel side bearing for an articulated railroad car. The bearing unit includes a filler material or spacers 64, 65 provided in two strips along the forward side and rear side of the outside of a sleeve member 62, between the sleeve member and the top cap member. The spacers permit sliding of the top cap member around the sleeve member. The spacers also permit the top cap member 52 to rock about a longitudinal axis with respect to the base portion 60. (Curtis, col. 4, ll. 61 - 68, col. 5, ll. 1 - 2). "Preferably a minimum gap is provided between spacers 64, 65 and side portion 58. The filler material [spacers] is preferably steel." (See Curtis, col. 5, ll. 7 - 9).

Spencer discloses a railcar side bearing that automatically adjusts and compensates for wear between cap and base parts. The side bearing provides a constant contact side bearing having a self adjusting spacing member between the cap and base parts. (See Spencer, col. 1, ll. 55 - 62). Spencer further discloses "each embodiment of the spacing member 78, that is either rollers 80, 82 or wedges 100, 102, will self adjust to any increase in separation between the cap member generally 50 and base member generally 20 by moving downwardly between converging sloped surfaces. Furthermore, both embodiments of spacing member 78 will freely move upward and downward with corresponding movement of the cap member...". (See Spencer, col. 3, ll. 22 - 30).

Carlston is cited as the primary reference wherein the Examiner has allegedly identified all of the elements of claim 1 except for: 1) at least one slip lining positioned between said first housing exterior surface and a bore wall defining said second housing bore; and 2) at least one compression spring ... wherein said compression spring comprises a solid resilient material having a toroidal shape.

With regard to the solid torus shaped compression spring, the Examiner states that Magowan teaches a solid torus shaped compression spring and that it would have been obvious to one of ordinary skill in the

art at the time the invention was made to have included a solid toroid according to the teachings of Magowan in an assembly according to Carlston in order to provide a biasing means with a high degree of elasticity but also with great economy and cheapness. (Final Office Action, ¶ 2, ll. 15 -18).

Additionally, the Examiner has acknowledged, quoting In re Fine, 837 F.2d 1071, "that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art." (See Final Office Action, ¶ 5, ll. 6 - 11). Here, the Examiner has cited, as motivation to combine the solid toroidal spring of Magowan with the Carlston side bearing unit, the following partial sentence from the Magowan reference: "... whereby is provided a spring having a high degree of elasticity, together with great bearing strength, and which may be manufactured with great economy and consequent cheapness." (Magowan, p. 1, col. 1, ll. 10 - 13).

Appellant respectfully submits that this excerpt from the Magowan reference does not provide a motivation or suggestion to combine the teachings of Magowan with the Carlston reference. "To support the conclusion that the claimed combination is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed combination or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references...". Ex parte Clapp, 227 U.S.P.Q. 972, 973 (B.P.A.I, 1985). Here, the quote from the Magowan reference does not expressly or impliedly suggest the bearing pad assembly as recited in Appellant's claim 1. Additionally, the Examiner has not presented any line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the identified teachings of the Magowan reference.

"When the incentive to combine the teachings of the references is not readily apparent, it is the duty of the examiner to explain why combination of the reference teachings is proper .... Absent such reasons or

incentives, the teachings of the references are not combinable." Ex parte Skinner, 2 U.S.P.Q.2d 1788, 1790 (B.P.A.I, 1986).

Appellant submits that it is not apparent from the partial statement identified by the Examiner in the Magowan disclosure as to why the combination of references is proper. To provide a motivation or suggestion to make the combination, "the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination." Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick Co., 221 U.S.P.Q. 481, 485 (Fed. Cir. 1984). Thus, to provide a suggestion or motivation sufficient to support the cited combination, the Magowan reference must teach or suggest providing a bearing unit having a solid toroid spring in a bearing pad assembly having the structure of the Carlston bearing unit. The Examiner has not identified anything in the references that suggests the desirability of the cited combination.

Because the Examiner has not explained the specific understanding or principle within the statement identified in the Magowan reference that would motivate one to make the cited combination, it must be inferred that the Examiner has selected these references with the assistance of impermissible hindsight reconstruction. "This court forbids the use of hindsight in the selection of references that comprise the case of obviousness." In re Rouffet, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998).

Still referring to the rejection of claim 1 under 35 U.S.C. § 103(a) based on the combination of the Carlston, Magowan, Platkiewicz, Curtis, and Spencer references, the Appellant submits that the Carlston reference teaches away from the cited combination of including a solid toroid according to the teachings of Magowan in a bearing assembly according to Carlston. It is improper to combine the references where the references teach away from their combination. In re Grasselli, 218 U.S.P.Q. 769, 779 (Fed. Cir. 1983); See also MPEP § 2145, X, D, 2.

As mentioned above, the Carlston side bearing unit is designed using a hollow spring specifically designed to fold and flex under load and provide a flat force versus travel curve as opposed to the the solid spring of Magowan designed to compress providing increased resistance

throughout its travel. As clearly stated in the Application, and illustrated in Fig. 3 thereof, a solid resilient toroid yields a non-linear spring, (i.e., a spring in which the relationship between compression and force defines a line whose slope is not constant). (See Application, p. 3, ll. 18 and 19; pg. 6, ll. 16 -18; Fig. 3). Thus, a solid toroid spring, such as the Magowan spring, produces a high spring rate, exactly the opposite as that desired by Carlston. Therefore, Carlston specifically teaches away from using a solid spring such as that of Magowan and does not support the cited combination.

The Examiner has acknowledged that Carlston teaches away from the combination and has responded "instead of using Carlston's hollow spring, it would have been obvious to one of ordinary skill in the art to which the invention pertains at the time the invention was made to have used the solid spring of Magowan for it's [sic] cheapness economy, and elasticity." (See Final Office Action, ¶ 5, ll. 15 -17 and 19 -22). The Examiner's logic is flawed. The section 103 rejection is based on the Applicant's claimed bearing pad assembly as allegedly being obvious over the structure of the Carlston side bearing unit in combination with the solid toroidal spring of Magowan. Because the Carlston reference teaches away from the claimed invention, Carlston is not a proper reference to support the combination.

Further, with respect to the Carlston reference teaching away from the cited combination, the Examiner has stated, "However, Applicant has merely identified Carlston's invention." (See Final Office Action, ¶ 5, ll. 17 and 18). Appellant's argument is that, taken by itself, the Carlston reference teaches away from the cited combination wherein a side bearing pad as disclosed by Carlston is combined with the solid spring of Magowan. Although the above-identified Grasselli citation includes the word "references" in a plural form, all of the references of the cited combination do not have to teach away from the combination to render the combination improper to support an obvious rejection. Here, because the Carlston reference specifically teaches away from the cited combination, the Carlston reference itself, is an improper reference in the combination, and does not support the obviousness rejection. Thus, the

rejection of claims 1, 3, 5 - 8, 10 - 14, 17 and 18 under 35 U.S.C. §103(a) based on the combination of Carlston, Magowan, Platkiewicz, Curtis, and Spencer references should be reversed.

Appellant's independent claim 1 further recites "at least one slip lining positioned between said first housing exterior surface and a bore wall defining said second housing bore;". The slip linings 50 and 52 ensure that the present invention, when subjected to a load, compresses essentially along its assembly axis 20 by occupying space between the first and second housings 30 and 40 respectively. (See Application, p. 5, ll. 18 - 20). The Examiner has acknowledged that Carlston in view of Magowan do not disclose at least one slip lining positioned between the first housing exterior surface and a bore wall defining the second housing bore. (See Final Office Action, p. 3, ll. 5 - 6).

To support the §103(a) rejection of claims 1, 3, 5 - 8, 10 - 14, 17 and 18, with respect to the slip lining positioned between the first housing exterior surface and a bore wall defining the second housing bore, the Examiner has included the combination of the Platkiwicz, Curtis, and Spencer, in addition to the Carlston and Magowan references. The Examiner has determined the following: Platkiewicz discloses a low friction slide lining composition and method of producing the slide lining composition; Curtis discloses a long travel side bearing for an articulated railroad car, see Fig. 6 including spacers 64, 65; and Spencer discloses self adjusting constant contact side bearings for railcars, see Fig. 4, including shims 100, 102. According to the Examiner, it would have been obvious to one of ordinary skill in the art at that time of the invention was made to have included a slip lining as taught by Platkiewicz between the first housing and a bore wall defining the second housing bore in order to improve utilization of slide surfaces. (See Final Office Action, p. 3, ll. 5 - 6).

Appellant further submits that the Examiner has not identified a motivation to combine these references. Curtis discloses filler material or spacers on the sleeve member 62 spaced apart from the top cap member 52 so that the top cap member can to rock about a longitudinal axis with respect to the base portion. (See Curtis, col. 4, ll. 61 - 68, col. 5, ll. 7 - 9).

Spencer, on the other hand discloses a spacing member 78 that moves freely move upward and downward with corresponding movement of the cap member. (See Spencer, col. 3, ll. 28 - 30).

Although, Plakiewicz may disclose a material for the slip lining of claim 1, there is no motivation to combine the references of Carlston, Magowan, Plakiewicz, Curtis, and Spencer such that the bearing pad assembly having a slip lining positioned between the first housing exterior surface and the bore wall defining the second housing bore of the present invention would have been obvious in view of the cited combination of references.

The Examiner has not identified anything in the Carlston, Magowan, Plakiewicz, Curtis or Spencer references that teach, suggest or provide any motivation to combine these references. The only way in which the Carlston, Magowan, Plakiewicz, Curtis, and Spencer references, can be combined to teach the present invention is if the Examiner improperly practices hindsight reconstruction based on the disclosure of the present application. This practice is not permissible. The prior art cited against a patent application must be viewed without reading the application's teachings into the references. Vandenberg v. Dairy Equipment Co., 224 U.S.P.Q. 195 (Fed. Cir. 1984); Kansas Jack v. Kuhn, 219 U.S.P.Q. 857 (Fed. Cir. 1983). When prior art references must be selectively combined, as done here by the Examiner, to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself. Uniroyal, Inc. v. Rudkin-Wiley Corp., 5 U.S.P.Q.2d at 1438, Ashland Oil, Inc. v. Delta Resins and Refractories, Inc., 227 U.S.P.Q. 657, 664 (Fed. Cir. 1985) cert. denied, 475 U.S. 1017 (1986).

Accordingly, for at least the reasons set forth above, the subject matter of the invention recited in claims 1, 3, 5 - 8, 10 -14, 17 and 18, as a whole, would not have been obvious to one of ordinary skill in the art. Thus, the rejections of claims 1, 3, 5 - 8, 10 -14, 17 and 18 under 35 U.S.C. §103(a) as being unpatentable over Carlston in view of Magowan in view of Platkiewicz and further in view of Curtis and Spencer should be reversed.

### Claims 11 and 12

Appellant respectfully directs the Board to the comments above as they also apply to claims 11 and 12. For at least those reasons, Appellant respectfully requests the Board to reverse the Examiner's rejection of claims 11 and 12. The comments provided below, however, will establish the further patentability of claims 11 and 12.

Claims 11 and 12 of the present application recite a bearing pad assembly having a slip lining attached to the first and second housing bore walls respectively. Neither of the Carlson, Magowan, Plakiewicz, Curtis, and Spencer references, nor the combination thereof, teach or suggest a side bearing pad having a slip lining attached to the first and second housing bores as recited in Appellant's claims 11 and 12 respectively. "To establish prima facie obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art". In re Royka, 180 U.S.P.Q. 580 (CCPA 1974). Here, the Examiner has not established prima facie obviousness. Accordingly, Appellant respectfully requests the Board to reverse the Examiner's rejection of claims 11 and 12.

Additionally, claims 3, 5 - 8, 13 - 14, 17 and 18 depend from claim 1 and include additional limitations. Thus, as claim 1 is not obvious under 35 U.S.C. § 103(a) over Carlson in view of Magowan in view of

Platkiewicz and further in view of Curtis and Spencer, for at least the above-identified reasons, claims 3, 5 - 8, 10 - 14, 17 and 18 are also not obvious under 35 U.S.C. §103(a) over Carlson in view of Magowan in view of Platkiewicz and further in view of Curtis and Spencer.

Accordingly, the rejection of claims 3, 5 - 8, 13 - 14, 17 and 18 under 35 U.S.C. §103(a) over Carlson in view of Magowan in view of Platkiewicz and further in view of Curtis and Spencer should be reversed and these claims allowed.

### Issue 2

The Examiner has rejected claims 15, 19 and 20 under 35 U.S.C. § 103(a) over Carlson in view of Magowan.

All of the arguments made hereinabove regarding the combination of Carlson and Magowan references with respect to claim 1 apply equally

to claim 15. Claim 15 recites the bearing pad unit of claim 1 without the slip lining.

Accordingly, for at least the above-identified reasons, the Examiner's rejection of claim 15 under 35 U.S.C. § 103(a) over Carlston in view of Magowan is improper and should be reversed.

Claims 19 and 20 depend from claim 15 and recite additional limitations thereto. Since, for at least the above-identified reasons, claim 15 is not obvious over Carlston in view of Magowan, dependent claims 19 and 20 are also not obvious over Carlston in view of Magowan. Therefore, the rejection of claims 19 and 20 under 35 U.S.C. § 103(a) should be reversed and claims 19 and 20 passed to issue.

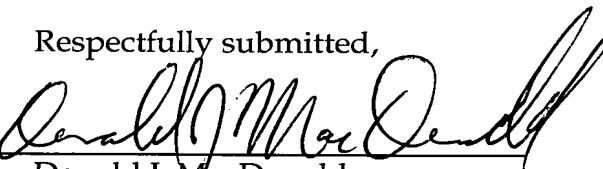
### Issue 3

The arguments made hereinabove with respect to claims 11 and 12, apply equally to claims 21 and 22. The combination of the Carlston, Magowan, Plakiewicz, Curtis, and Spencer references do not teach or suggest a side bearing pad having a slip lining attached to the first and second housing bores as recited in Appellant's claims 21 and 22 respectively. Thus, the invention recited in Appellant's claims 21 and 22 also patentably distinguish over the cited references. Accordingly, the rejection of claims 21 and 22 under 35 U.S.C. §103(a) over Carlston in view of Magowan in view of Platkiewicz and further in view of Curtis and Spencer should be reversed and these claims allowed.

CONCLUSION

In view of the foregoing, Appellant submits that the rejections of claims 1, 3, 5 - 8, 10 -15 and 17 - 22 under 35 U.S.C. § 103(a) are not well founded. Accordingly, Appellant respectfully requests the Board of Patent Appeals and Interferences to reverse the rejections in the present case and allow claims 1, 3, 5 - 8, 10 -15 and 17 - 22 to issue. A check in the amount of \$320.00 pursuant to 37 CFR § 1.17(c) for filing the Appeal Brief is submitted herewith. In the event any additional fee is due with this filing, please charge our Deposit Account No. 13-0235.

Respectfully submitted,

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## Appendix

The claims involved in the present appeal are as follows:

1. A bearing pad assembly comprising:

    a first housing having an exterior surface and defining a bore extending at least part-way through said first housing;

    a first load bearing member coupled to said first housing, and defining an outwardly facing first abutment surface;

    a second housing defining a bore of a shape similar to said exterior surface of said first housing and adapted to slideably receive said first housing therein;

    a second load bearing member coupled to said second housing and defining an outwardly facing second abutment surface opposite to said first abutment surface;

    at least one slip lining positioned between said first housing exterior surface and a bore wall defining said second housing bore; and

    at least one compression spring positioned within said first housing bore, wherein said compression spring comprises a solid resilient material having a toroidal shape, the toroid having an outside diameter minus an inside diameter equal to or greater than a height when positioned in the bearing pad assembly.

3. The assembly of claim 1 wherein the compression spring deforms non-linearly in response to said load imposed on at least one of the first and second abutment surfaces.

5. The assembly of claim 1 wherein said solid resilient material is substantially an organic polymer.
6. The assembly of claim 5 wherein said organic polymer is substantially polyurethane.
7. The assembly of claim 1 wherein the solid resilient material is in the form of a toroidal ring having a circular cross-section.
8. The assembly of claim 1 wherein the compression spring includes:
  - at least two springs; and
  - a plate positioned between the springs, separating the springs from one another.
10. The assembly of claim 1 wherein the slip lining has a coefficient of static friction less than that of the first housing.
11. The assembly of claim 1 wherein the slip lining is attached to the first housing exterior surface.
12. The assembly of claim 1 wherein a second slip lining is attached to the second housing bore wall.
13. The assembly of claim 1 wherein the slip lining is made substantially of an organic polymer.

14. The assembly of claim 13 wherein the slip lining is made substantially of polypropylene.

15. A bearing pad assembly comprising:

- a first housing having a bore extending through said first housing;
- a first load bearing member coupled to said first housing and defining an abutment surface opposite to said first housing;
- a second housing having a bore extending through said second housing, adapted to telescopically receive said first housing;
- a second load bearing member coupled to said second housing and defining an abutment surface opposite to said second housing; and
- at least one compression spring in the shape of a toroid positioned within said first housing bore, the toroid having an outside diameter minus an inside diameter equal to or greater than a height when positioned in the bearing pad assembly.

17. The assembly of claim 1 wherein the compression spring has a largest diameter slightly smaller than that of the first housing bore.

18. The assembly of claim 1 wherein an inner most point of a cross section of the toroidal shape of said compression spring is on a line drawn perpendicular to an axis of rotation of the spring through the geometric center of the cross section.

19. The assembly of claim 15 further comprising two compression springs positioned within said first housing bore.

20. The assembly of claim 19 further comprising a plate positioned between the springs, separating the springs from one another.

21. The assembly of claim 15 further comprising a first slip lining attached to said first housing exterior surface.

22. The assembly of claim 21 further comprising a second slip lining attached to the second housing bore wall.